

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO ELECTION RESTRICTION REQUIREMENT OF OCTOBER 30,
2008

| | | |
|-------------|---|------------------------|
| APPLICANTS: | Robert HEIMBACH et al | Group Art Unit: 2854 |
| SERIAL NO.: | 10/532,293 | Examiner: Jung Hun Nam |
| FILED: | December 20, 2005 | Confirmation No. 8611 |
| FOR | "METHOD AND DEVICE FOR CONTROLLING AN ELECTROGRAPHIC PRINTER OR COPIER | |

MAIL STOP AMENDMENT

Commissioner of Patents
P. O. Box 1450
Alexandria, VA 22313-1450

S I R:

In the October 30, 2008 Restriction Requirement, the Examiner makes a restriction between Groups I-XV1. Applicants hereby elect, with traverse, Group I claims 50, 51, 72 and 100.

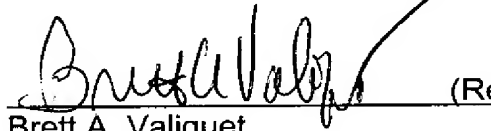
Applicants traverse this requirement because at page 5 of the Office Action, relying on PCT Rule 13.1 and 13.2, the Examiner states the claims do not relate to a single general inventive concept, since they lack the same or corresponding special technical features. However, Applicants claims 50-72 correspond to PCT substitute claims 1-23. Applicants claims 50-72 are based on the PCT prosecuted substitute page claims 1-23 but are drawn in accordance with U.S. practice. In the attached translation of the International Preliminary Examination Report filed with the U.S. Patent Office and dated July 7, 2005, at page 5 (Part 1: claims 1-23) the PCT Examiner cited the same two prior art documents D1 and D4 relied upon by the Examiner for making the instant restriction requirement on the basis that these two prior art patents show the common features of the Groups and that therefore a lack of unity exists posteriori and restriction is proper. However, the Examiner's

conclusion is directly contrary to the PCT Examiner's conclusion under Part 1: Claims 1-23 where the PCT Examiner concludes on the following page 6 of that translation that claims 1-23 involve an inventive step and that the references cited by the Examiner herein (D1 and D4) contain no suggestion as to the solution used in claims 1 and 23; and that since claims 2-22 are dependent on claim 1 they therefore also likewise meet the PCT novelty and inventive step requirements.

In view of the above, the Examiner should reverse his restriction requirement concerning claims 50-72. And since claims 99 and 100 are similar to claim 50, the Examiner should also not make a restriction requirement as to these claims also.

In conclusion, all claims 50-72 and 99 and 100 should be examined together.

Respectfully submitted,

 (Reg.No.27,841)

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CHI\6111252.1

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rule 72.2)

To:

SCHAUMBURG, Karl-Heinz

Postfach 86 07 48

81634 München

ALLEMAGNE

EINGEGANGEN

07. Juli 2005

Erled.

Date of mailing (*day/month/year*)
30 June 2005 (30.06.2005)

Applicant's or agent's file reference
2002-1031 P

IMPORTANT NOTIFICATION

International application No.
PCT/EP2003/011488

International filing date (*day/month/year*)
16 October 2003 (16.10.2003)

Applicant
OCÉ PRINTING SYSTEM GMBH et al

1. Transmittal of the translation to the applicant.

The International Bureau transmits herewith a copy of the English translation made by the International Bureau of the international preliminary examination report established by the International Preliminary Examining Authority.

2. Transmittal of the copy of the translation to the elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following elected Offices requiring such translation:

CN

The following elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

EP, JP, US

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report.

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

Translation

PATENT COOPERATION TREATY

PCT/EP2003/011488



PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

| | | |
|--|--|--|
| Applicant's or agent's file reference 2002-1031 P | FOR FURTHER ACTION See Form PCT/IPEA/416 | |
| International application No. PCT/EP2003/011488 | International filing date (day/month/year) 16 October 2003 (16.10.2003) | Priority date (day/month/year) 28 October 2002 (28.10.2002) |
| International Patent Classification (IPC) or national classification and IPC G03G 15/00 | | |
| Applicant OCÉ PRINTING SYSTEM GMBH et al. | | |

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 8 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
 - a. ☒ (sent to the applicant and to the International Bureau) a total of 35 sheets, as follows:
 - ☐ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
 - ☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
 - b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).
4. This report contains indications relating to the following items:

| | |
|---|---|
| <input checked="" type="checkbox"/> Box No. I | Basis of the report |
| <input type="checkbox"/> Box No. II | Priority |
| <input type="checkbox"/> Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI | Certain documents cited |
| <input type="checkbox"/> Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> Box No. VIII | Certain observations on the international application |

| | |
|--|---|
| Date of submission of the demand 27 May 2004 (27.05.2004) | Date of completion of this report 15 April 2005 (15.04.2005) |
| Name and mailing address of the IPEA/EP | Authorized officer |

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2003/011488

Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

- ☐ This report is based on translations from the original language into the following language _____, which is language of a translation furnished for the purpose of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on (replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):

- ☒ The international application as originally filed/furnished

- ☒ the description:

pages _____, as originally filed/furnished

pages* 1, 3-9, 11, 12, 16-22, 24, 25, 27, 34, 36- received by this Authority on 22 March 2005 (22.03.2005)

pages* 10, 13-15, 23, 26, 28-33, 35, 40, 41, 43, 2, received by this Authority on 11 April 2005 (11.04.2005)

- ☒ the claims:

pages _____, as originally filed/furnished

pages* _____, as amended (together with any statement) under Article 19

pages* _____ received by this Authority on _____

pages* _____ received by this Authority on _____

- ☒ the drawings:

pages _____, as originally filed/furnished

pages* 35-49 received by this Authority on 22 March 2005 (22.03.2005)

pages* 1-34 received by this Authority on 11 April 2005 (11.04.2005)

- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (specify): _____
- ☐ any table(s) related to sequence listing (specify): _____

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/figs _____
- ☐ the sequence listing (specify): _____
- ☐ any table(s) related to sequence listing (specify): _____

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: IV. 3

The International Searching Authority has determined that this international application contains several (groups of) inventions, namely:

I. Claims: 1-23

Method and device for controlling an electrographic printer or copier, in which a desired time relative to the system time is set at which at least one sensor signal is expected and/or an actuator is activated, the system time being independent of the passage of the individual sheet of paper.

II. Claims: 24-34

Method and device for controlling an electrographic printer or copier, with a first operating mode in which individual sheets can be printed on the recto by a first printing unit and on the verso by a second printing unit, and a second operating mode in which a plurality of successive individual sheets can be printed alternately on the recto by the first printer unit or by the second printing unit, the switchover from the first operating mode to the second operating mode being made only if at least a specific number of individual sheets are to be printed on the recto, otherwise the sheets that are to be printed continue to be supplied in the first operating mode to the first and second printing units without the second printing unit producing a printed image on the verso of the individual sheets.

III. Claims: 35-49

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: IV.3

electrographic printer or copier, wherein the speed of feed is regulated as a function of a comparison between a desired and an actual value for the arrival of the paper.

For the following reasons, these inventions/groups are not so linked as to form a single general inventive concept (PCT Rule 13.1):

~~The search revealed the following prior art relevant for assessing unity of invention: D1: US 5 489 969.~~

D1 (column 9, line 15 - column 13, line 40, figures 1, 10-12) discloses a method and a device for controlling paper in an electrographic copier, in which a feed path is determined as a function of a function mode (i.e. print data) (column 12, lines 1-38) and desired times ("sync signals") are fixed at which a sheet is to be fed from a paper tray (column 13, lines 1-14) and an actuator ("clutch") is to be actuated.

The relationship between the desired times and the system time of the printer which is independent of the passage of the paper is considered a feature of claim 1 which makes a contribution over the prior art and which can therefore be considered a special technical feature according to PCT Rule 13.2.

The inventions of groups II and III do not contain any of the same or corresponding special technical features and therefore there is no technical relationship (PCT Rule 13.2) between the subjects of the aforementioned groups

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
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V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

| | | | |
|-------------------------------|--------|------|-----|
| Novelty (N) | Claims | 1-49 | YES |
| | Claims | | NO |
| Inventive step (IS) | Claims | 1-49 | YES |
| | Claims | | NO |
| Industrial applicability (IA) | Claims | 1-49 | YES |
| | Claims | | NO |

2. Citations and explanations

The following statements are divided into three parts with respect to the three above-mentioned inventions.

PART 1: Claims 1-23

Reference is made to the following documents:

D1: US 5 489 969

D2: US 5 374 045

D3: US 4 589 765

D4: JP 08 036 2823

D1 is considered the prior art closest to the subject matter of claims 1 and 23. D1 discloses (column 9, line 15 - column 13, line 40, figures 1, 10-12) a method and a device for controlling paper in an electrographic copier, in which a feed path is determined as a function of a function mode (i.e. print data) (column 12, lines 1-38), and desired times ("sync signals") are set at which a sheet of paper is to be fed from a paper tray (column 13, lines 1-14) and an actuator ("clutch") is to be actuated.

The subject matter of claims 1 and 23 differs therefore from the method and device known from D1 in that the

paper.

The problem addressed by the present invention can therefore be considered that of centrally controlling the paper supply.

The solution to this problem proposed in claims 1 and 23 of the present application involves an inventive step for the following reasons (PCT Article 33(3)):

D1 contains no suggestion as to the solution used in claims 1 and 23, nor is it suggested by the other documents D2-D4 cited in the international search report.

Claims 2-22 are dependent on claim 1 and therefore likewise meet the PCT novelty and inventive step requirements.

PART 2: Claims 24-34

Reference is made to the following documents:

D6: US 4 591 884

D7: US 5 598 257

D9: WO 98 18052

D9 is considered the prior art closes to the subject matter of claims 24 and 34. D9 discloses (page 7, line 1 - page 9, line 15, figures 2-5) an electrographic printer or copier and a method for controlling same, in which, in a first operating mode for double-sided printing (page 8, line 17 - page 9, line 15) of a first individual sheet using a first printing unit *D1* (given here in italics so as to avoid confusion with the documents), a printed image is produced on the recto of the first sheet and, using a second printing unit *D2*, a printed image is produced on the verso of the first sheet.

printing unit *D1* and to the second printing unit *D2*, in a second operating mode for single-sided printing (page 7, line 16 - page 8, line 15) of individual sheets using the first printing unit *D1*, a printed image is produced on the recto of a second individual sheet and, using the second printing unit *D2*, a printed image is produced on the recto of a third individual sheet, the second sheet being supplied along a second feed path 44 to the first printing unit *D1* and the third sheet along a third conveyor path 50 to the second printing unit *D2*.

The subject matter of claims 24 and 34 differs therefore from the method and device known from *D9* in that the switchover from the first operating mode to the second operating mode is made only when at least a specific number of individual sheets are to be printed on the recto; otherwise the sheets to be printed continue to be supplied in the first operating mode to the first and second printing units without the second printing unit producing a printed image on the verso of the individual sheets.

The solution to this problem proposed in claims 24 and 34 of the present application involves an inventive step for the following reasons (PCT Article 33(3)):

D9 contains no suggestion as to the solution used in claims 1 and 23, nor is it suggested by the other documents *D6* or *D7* also cited in the international search report.

Claims 25-33 are dependent on claim 24 and therefore likewise meet the PCT novelty and inventive step requirements.

PART 3: Claims 35-49

Reference is made to the following document:

D10: WO 98 180 60 (30/04/1998)

D10 is considered the prior art closest to the subject matter of claims 35, 36 and 47. D10 discloses (entire document, especially page 8, line 11 - page 15, line 15, figures 1-8): a method and a device for controlling an electrographic printer or copier in which individual sheets are printed by at least one printing unit (D1, D2), wherein the sheets are fed through the printer or copier along at least one feed path (figure 4-7) and are supplied to the printing unit (D1, D2). The passage of the front or rear edge of a sheet on a pair of rolls is detected by a photoelectric sensor L for the purpose of position identification and the speed of feed is increased or decreased as a function of the operating mode (page 13, lines 1-12).

The subject matter of claims 35, 36 and 47 differs therefore from the method and device known from D10 in that the speed of feed is regulated as a function of a comparison between the actual value for the arrival of the paper and a corresponding desired value therefor (claim 35), that is, the time at which the speed is altered is determined as a function of the comparison (claim 36; claim 47 relates to the corresponding device, which is equipped to carry out the two alternatives of claims 35 and 36).

The solution to this problem proposed in claims 35, 36 and 47 of the present application involves an inventive step for the following reasons (PCT Article 33(3)): D10 does

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Claims 37-46 and 48, 49 are dependent on claims 24 and 47 and therefore likewise meet the PCT novelty and inventive step requirements.

Industrial applicability (all three inventions)

The subject matter of the application is industrially applicable in the field of electrographic printing or copying.

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VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

The back references in claims 44-46 do not reflect the renumbering of these claims.